REMARKS/ARGUMENTS

Claims 11-16 remain in this application. New claim 16 has been added in this response. No new matter has been introduced as a result of this amendment. In addition to this response, the Applicants would like to request an Examiner Interview to further discuss the merits of the present application.

Claims 11-15 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Coursey et al.* (US Patent 5,995,839) in view of *Hjern et al.* (US Patent 5,873,033). Claims 13 and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Coursey et al.* (US Patent 5,995,839) in view of *Hjern et al.* (US Patent 5,873,033) further in view of *Choi* (US Patent 6,278,883). Applicant respectfully traverses the rejection. Favorable reconsideration is requested.

Specifically, the cited art, alone or in combination, does not disclose, among other things, "controlling the telecommunications connections by the base stations in uncoordinated, unlicensed system operation of the telecommunications system and in coordinated, licensed system operation of the telecommunications system," along with the receiving, assessing and transmitting messages and parameters as recited in claim 11, and similarly recited in claim 16. Neither *Coursey* nor *Hjern* teach a cellular telecommunication system using wireless telecommunication wherein a first base station, supporting an uncoordinated, unlicensed system operation, is operated independently from a second base station being adjacent to the first base station and supporting a coordinated, licensed system operation or supporting (as the first base station) an uncoordinated, unlicensed system operation. The independent operation of both base stations of the presently claimed invention is such that the first base station listens only to a first telecommunications broadcast control channel on which the second base station sends messages relevant for handing off telecommunications connections without being linked/connected to the second base station.

Unlike the base stations of the presently claimed invention, the base stations of *Coursey* and *Hjem* are operated dependently from each other. Under the teaching of *Coursey*, the Private/Residential Base Station (PRBS), (i.e. "first base station") is connected to a Mobile Station Emulator (MSE), whereby the Mobile Station Emulator itself communicates with a base

station within a radio network over the Digital Control Channel (DCCH) (see col. 3, lines 40-51; col. 5, lines 14-30). The Private/Residential Base Station and the Mobile Station Emulator of *Coursey* emulates a repeater, which combines the function of a cellular mobile station and a cordless base station and is further connected to the base station of the radio network on one side and to the Public Switched Telephone Network (PSTN) on the other side (FIG. 1 and accompanying text).

The repeater at *Coursey* et al however is wholly silent with regard to the first base station listening to the broadcast control channel without establishing a telecommunication link to the transmitter (which uses the broadcast control channel) in order to receive information for handing off telecommunications connections and to forward this received information by broadcasting it to mobile terminals located in the cell covered by the first base station. The repeater (MSE) of *Coursey* uses the Digital Control Channel in order to monitor messages from the base station of the radio network, which are transferred afterwards to the Private/Residential Base Station. In other words, the *Coursey* reference does not teach to broadcast messages, but rather teaches the use of a repeater for receiving messages.

Additionally, under *Coursey*, the base station of the radio network controls the hand-off of the mobile stations. Accordingly, *Coursey* must rely on a Mobile Assisted Hand-Over (MAHO). In contrast, the presently claimed invention teaches that the first base station in the telecommunications system does not control the hand-off of the mobile stations but only assists the mobile station for handing off telecommunications connections. In other words the presently claimed methods teach a Base Station Assisted Hand-Over (BSAHO), which is a different mode of operation.

Hjern teaches a DECT-based Central Fixed Part (CFP) and a DECT-based Radio Fixed Part (RFP) connected to each other and are further connected to a Private Branch Exchange (PABX) (FIG. 1, col. 4, lines 15-26). The Private Branch Exchange is connected to and communicates with a Mobile Switching Center (MSC) that includes a Base Station Controller (BSC) within a GSM-based radio network over a ISDN-based interface or a GSM-based A-interface. Under this teaching, the Central Fixed Part and the Radio Fixed Part are operated dependently with respect to handing off telecommunication connections. And due to the

controlling function of the Mobile Switching Center, Hjern also teaches a Mobile Assisted Hand-Over (MAHO) and not a Base Station Assisted Hand-Over (BSAHO).

Furthermore, Applicants submit that it is improper to combine the *Coursey*, *Hjern* and *Choi* references in the manner suggested by the Office Action. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). (MPEP 2142). When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983) (MPEP 2141.02). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination (MPEP 2143.01). In other words, the suggestion or desirability to combine reference must come from the references themselves, and not from the applicant's disclosure.

Coursey teaches a system and method for a Mobile Station Emulator to re-route existing telephone connections between a Private/Residential base station and a cellular telephone system (col. 2, lines 26-49). *Hjern* however, teaches an arrangement for a transfer between a cordless DECT system and a cellular GSM system under overlap conditions (col. 2, lines 57-65). There is no teaching, suggestion or motivation for one skilled in the art to modify the *Coursey* reference with the teaching in *Hjern*. Likewise, there is no motivation to combine *Choi* (message control center broadcasting), and the reference further does not solve the deficiencies of *Coursey* and *Hjern*, discussed above.

In light of the above, Applicants respectfully submit that independent claims 11 and 16 of the present application, as well as dependent claims 12-15, are both novel and non-obvious over

the prior art. Accordingly, Applicants respectfully request withdrawal of the Examiner's §103(a) rejections of the claims and respectfully request that a timely Notice of Allowance be issued in this case.

If any additional fees are due in connection with this application as a whole, the Examiner is authorized to deduct said fees from Deposit Account No.: 02-1818. If such a deduction is made, please indicate the attorney docket number (0112740-450) on the account statement.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY _____
Peter Zura
Reg. No. 48,196
P.O. Box 1135
Chicago, Illinois 60690-1135
Phone: (312) 807-4292

Dated: December 20, 2004